

REMARKS

Examination of the above-identified application in view of the present amendment is respectfully requested.

Claims 10, 11, and 19-23 have been rejected as anticipated by Yagyu et al., US 5,899,955. Claim 10 recites a sensor for scanning a part of a predefined search area.

The Examiner's cooperation during the telephone interview of April 12, 2005 is greatly appreciated. As discussed at that time, Yagyu et al. do not disclose a sensor for scanning a part of a predefined search area.

Furthermore, if the Examiner rejects claim 10 as obvious over Yagyu et al., the M.P.E.P. sets forth the following criteria for an obviousness rejection under 35 U.S.C. §103:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

See, MPEP §706.02(j).

Claim 10 recites a system implementing an algorithm by a computer (Specification, page 9, lines 11-15). The structure of a computer programmed to carry out an algorithm is limited by the disclosed algorithm. See WMS Gaming Inc. v. Int'l Game Tech., 184 F.3d 1339, 1348 (Fed. Cir. 1999). A new machine (a special purpose computer) is created when a general purpose computer is programmed to carry out an algorithm for performing one or more particular functions. Id. citing In Re Alappat, 33 F.3d 1526, 1545 (Fed. Cir. 1994) (*en banc*). When a general purpose computer is programmed to perform a particular function by using a discovery not specified in the

prior art, the resulting device would not be obvious under 35 U.S.C. §103 "because one not having knowledge of the [inventor's] discovery simply would not know what to program the computer to do." See In re Prater, 415 F.2d 1393, 1397-98 (CCPA 1969).

For an obviousness rejection under 35 U.S.C. §103, the prior art must be analyzed at the time the invention was made. The use of the teachings of the present invention to find obviousness is impermissible.

Obviousness must not be read into an invention on the basis of applicant's own statements; that is, the prior art must be viewed without reading into that art the applicant's teachings. The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention obvious.

In Re Spinnoble, 160 USPQ 237, 243 (CCPA 1969) (emphasis in original). Accordingly, the Examiner must consider only the teachings of the prior art references.

Yagyu et al. does not disclose a sensor scanning a search area. Yagyu et al. only discloses a sensor using GPS to determine a position and then using a database of maps to determine a route for the sensor. Therefore, it is clear that the features of claim 10 are not taught by Yagyu et al.

According to WMS Gaming Inc., 184 F.3d at 1348, the structure of the system of the present invention is the algorithm for scanning the search area. Since Yagyu et al. fails to teach or suggest this feature, Yagyu et al. fails to teach or suggest a system having the structure for scanning the search area of claim 10. Since Yagyu et al. fails to

teach or suggest each feature of the claimed invention, it is respectfully submitted that the invention of claim 10 would not have been obvious to one of ordinary skill in the art.

Additionally, when an algorithm is not taught or suggested by the prior art, one of ordinary skill in the art would not know what to program a computer to do. See e.g., In re Prater, 415 F.2d at 1397-98. Thus, a new machine has been created when a general purpose computer is programmed to carry out an algorithm to perform a particular function, as in claim 10. WMS Gaming Inc., 184 F.3d at 1348. Therefore, it is respectfully submitted that it would not have been obvious for one of ordinary skill in the art to reprogram the apparatus of Yagyu et al. to scan a search area. Thus, it is respectfully submitted that a rejection of claim 10 as obvious over Yagyu et al. would be improper.

Furthermore, in rejecting claim 10 as obvious over Yagyu et al., it is respectfully submitted that improper hindsight would be required. The prior art fails to teach or suggest scanning a search area. Thus, without reference to the teachings of the disclosure of the present invention, one of ordinary skill in the art would not have the requisite knowledge to scan a search area, as recited in claim 10.

According to In Re Sponnoble, 160 USPQ at 243 (CCPA 1969), such hindsight is impermissible. Therefore, it is respectfully submitted that for this further reason, the rejection of claim 10 would be improper.

Consequently, claim 10, as well as claims 11 and 19-23 which depend from claim 10, are in condition for allowance.

In view of the foregoing, allowance of the above-identified application is respectfully requested.

Please charge any deficiency or credit any overpayment in the fees for this matter to our Deposit Account No. 20-0090.

Respectfully submitted,



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